

## REMARKS

Reconsideration of the above-identified patent application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-22 are in this case. Claims 1-22 have been rejected under § 103(a). Independent claims 1 and 15 and dependent claims 2-4, 7-13, 17, 20 and 22 have been amended.

The claims before the Examiner are directed toward methods for determining a licensing policy, for example a number of licenses in a licensing pool, for a the use of a digital product by a plurality of users. A tolerant licensing policy is conducted during a trial period. At least one parameter of the use of the digital product by the users during the trial period is monitored. Based on the monitoring, at least one optimization method is implemented to determine the subsequent licensing policy.

### **§ 103(a) Rejections – Ginter et al. ‘193 in view of Salas et al. ‘408**

The Examiner has rejected claims 1-22 under § 103(a) as being unpatentable over Ginter et al., US Patent No. 6,253,193 (henceforth, “Ginter et al. ‘193”) in view of Salas et al., US Patent No. 6,314,408 (henceforth, “Salas et al. ‘408”). The Examiner’s rejection is respectfully traversed.

Salas et al. ‘408 is cited only to show that a trial period is taught in the prior art. Therefore, the discussion herein focuses on Ginter et al. ‘193.

Ginter et al. ‘193 teach a system for managing the licensing of digital content. The licenses take the form of “content control information” (column 2 lines 49-50).

The crucial difference between the present invention and the teachings of Ginter et al. ‘193 is that in Ginter et al. ‘193 the determination of a licensing policy is only “top-down”, either imposed on the licensee by the licensor or negotiated between

the licensor and the licensee, whereas the present invention includes “bottom-up” determination of a licensing policy, in which the licensee dictates to the licensor what the licensing policy will be. Consider, for example, the example given in the specification of the above-identified patent application on page 4 lines 19-31:

For example, an organization intends to purchase licenses for using a digital product, e.g. a spreadsheet software, but it has no indication about the quantity of licenses required by the organization. During the first month, which is used as a trial period, the organization gets N licenses, where N is greater than the number of the members of the organization. During the trial period, the usage is monitored, and the usage information is registered in a database. The usage parameters may be one or more of the parameters listed above. After the trial period is over, the organization determines the quantity of licenses to purchase. The quantity of licenses to purchase (in an adjusted licensing policy according to the present invention) may be determined, for example, by the number of users that used the product for at least three times during the trial period (e.g. 150 users used the product 4 times, 200 users used the product 3 times, 250 used the product 2 times, and 400 users used the product one time, thus  $150+200=350$  licenses). (emphasis added)

In this example, the licensee (the organization), not the licensor (the vendor of the digital product) decides how many licenses to purchase.

Therefore, independent claims 1 and 15 have been amended to state that the step of determining the licensing policy (claim 1) and the step of determining the maximum available licenses (claim 15) are effected only by the user(s).

In a telephonic interview on August 30, 2005, the Examiner proposed that this distinction between the present invention and the cited prior art is insufficient to render patentable the present invention, as recited in independent claims 1 and 15. The Examiner proposed, as a well-known counterexample of a case of a licensee imposing license terms on a licensor, a cable TV subscriber deciding unilaterally to upgrade from a basic subscription to an expanded subscription. Therefore, Applicant has introduced two more new limitations in independent claims 1 and 15.

The first new limitation is that the digital product is to be used by a plurality of users of an organization. Support for this limitation is found in the specification *inter alia* on page 2 lines 24-25:

The present invention is of a method for determining a licensing policy of using a digital product by a group of users.  
(emphasis added)

and in the above citation from page 4 lines 19-31. The second new limitation, already present in claim 15 and now copied to claim 1, is that the licensing policy is determined by implementing at least one optimization method based on the monitoring of the parameter(s). Applicant submits that the three new limitations in combination (exclusively bottom-up optimization of the licensing policy by a plurality of users of an organization) is sufficiently nontrivially different from the cited prior art to overcome the Examiner's rejection. A single private user, for example the single subscriber of the Examiner's counterexample, does not need to use optimization methods to determine a licensing policy.

Dependent claim 2 has been amended, for consistency with independent claims 1 as now amended, to recite "said step of implementing" instead of "said step of determining". Also for consistency with independent claims 1 and 15 as now amended, dependent claims 7-13, 20 and 22 have been amended to recite a plurality of users.

With independent claims 1 and 15 allowable in their present form, it follows that claims 2-14 and 16-22 that depend therefrom also are allowable.

#### **Other Amendments to the Claims**

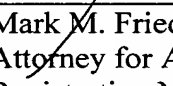
The redundant word "according" has been deleted from claim 2.

For clarity, the “determined” licensing policy of claims 1, 3 and 4 now is called a “new” licensing policy. This is purely a change in nomenclature that introduces no new matter.

The period (.) that was inadvertently omitted at the end of claim 17 now has been provided.

In view of the above amendments and remarks it is respectfully submitted that independent claims 1 and 15, and hence dependent claims 2-14 and 16-22 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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